

# UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DAVID PAUL AGNELLO, MARY CONROY BUSHEY,  
DONNA K. JOHNSON, JEROME BRETT LASKY,  
PETER JAMES LINDGREN and DAVID KIRK PETERSON

MAILED

OCT 27 2006

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application No. 09/939,895

### ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on October 3, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

The Appeal Brief filed December 21, 2005 is defective because the Summary of Claimed Subject Matter does not map the claimed invention to the independent claims as set forth in 37 CFR § 41/37 (c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to

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each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The Examiner's Answer mailed April 18, 2006 is defective because in paragraph 8 it is stated, "no evidence is relied upon by the examiner." However, prior art was applied in the rejections on appeal. The Manual of Patent Examining Procedure, (MPEP), in § 1207.02 states:

(8) *Evidence Relied Upon*<. A listing of the \*\*>evidence< relied on >(e.g., patents, publications, admitted prior art)<, and, in the case of nonpatent references, the relevant page or pages.

Appropriate correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief of December 21, 2005 defective;
- 2) for the applicant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for the examiner to vacate the Examiner's Answer mailed April 18, 2006 and issue a revised Examiner's Answer;
- 4) to list the prior art being relied on under the heading Evidence Relied Upon in paragraph 8 in the Examiner's Answer; and

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5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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